

REMARKS

Claims 14 and 15 are added, claim 8 has been canceled without prejudice, and therefore claims 7 and 9 to 15 are now pending in the present application.

It is respectfully submitted that all of the presently pending claims are allowable, and reconsideration is respectfully requested.

Applicants thank the Examiner for considering the previously filed Information Disclosure Statement, PTO 1449 paper and cited references.

Claims 8 to 11 were rejected under 35 U.S.C. 112, second paragraph, as indefinite.

Claim 8 has been canceled without prejudice and claims 9 to 11 have been amended to correct a minor inadvertent error. Claims 9 to 11 now depend from claim 7, and not previously canceled claim 1. Withdrawal of the indefiniteness rejection is therefore respectfully requested.

Claims 7 to 13 were rejected under 35 U.S.C. 102(b) as being anticipated by U.S. Patent No. 4,390,841 ("Martin").

As regards the anticipation rejections of the claims, to reject a claim under 35 U.S.C. § 102(b), the Office must demonstrate that each and every claim feature is identically described or contained in a single prior art reference. (*See Scripps Clinic & Research Foundation v. Genentech, Inc.*, 18 U.S.P.Q.2d 1001, 1010 (Fed. Cir. 1991)). As explained herein, it is respectfully submitted that the Office Action does not meet this standard, for example, as to all of the features of the claims. Still further, not only must each of the claim features be identically described, an anticipatory reference must also enable a person having ordinary skill in the art to practice the claimed subject matter. (*See Akzo, N.V. v. U.S.I.T.C.*, 1 U.S.P.Q.2d 1241, 1245 (Fed. Cir. 1986)).

As further regards the anticipation rejections, to the extent that the Office Action may be relying on the inherency doctrine, it is respectfully submitted that to rely on inherency, the Office must provide a "basis in fact and/or technical reasoning to reasonably support the determination that the allegedly inherent characteristics *necessarily* flows from the teachings of the applied art." (*See* M.P.E.P. § 2112; emphasis in original; and *see Ex parte Levy*, 17 U.S.P.Q.2d 1461, 1464 (Bd. Pat. App. & Int'f. 1990)). Thus, the M.P.E.P. and the case law make clear that simply because a certain result or characteristic may occur in the prior art does not establish the inherency of that result or characteristic.

While the rejection of previously presented claim 7 as being anticipated by the “Martin” reference is not agreed with, to facilitate matters, claim 7 have been rewritten to include the features of claim 8, which has been canceled without prejudice, and to further clarify the subject matter recited therein.

Claim 7, as presented, includes the feature of *“adapting continuously a parameter of the mathematical model to a real value over the lifetime of the energy storage mechanism.”* While the “Martin” reference may refer to comparing a predicted voltage and a measured voltage to correct a meter reading for self-calibration, it does not disclose nor suggest *adapting continuously a parameter of a mathematical model to a real value over the lifetime of the energy storage mechanism.*

The “Martin” reference, at col. 5, lines 9-16, states that: “The predicted voltage is compared to the measured voltage and the difference is used to correct the meter reading. This correction serves the purpose of self-calibration and can be used to determine the condition of the system as compared to an ideal battery. The voltage error is implemented by short and long term considerations and actually conforms to the battery behavior over a number of cycles.”

This is in stark contrast to the feature of *adapting continuously a parameter of a mathematical model*, as provided for in the context of the presently claimed subject matter. The “Martin” reference does not identically disclose (or even suggest) the feature of adapting continuously any parameters of any mathematical model, and instead only refers to correcting a meter reading, as provided for in the context of the presently claimed subject matter. Even if correcting a meter reading (as explained by the “Martin” reference) may allow for self-calibration, the “Martin” reference still does not identically disclose (or even suggest) a method of self-calibration which includes the feature of *adapting continuously a parameter of a mathematical model to a real value over the lifetime of the energy storage mechanism.*

Accordingly, claim 7 is allowable, as are its respective dependent claims 9 to 11 and 13. Claim 12 has also been rewritten to include similar features to those of claim 7, as presented, and is therefore allowable for the same reasons.

New claims 14 and 15 do not add any new matter and are supported by the present application. This support includes the specification at least at page 3, lines 3 to 4, page 5, lines 9 to 16, and Figure 1. As to claim 15, its features correspond to those of claims 9, 10

Application Serial No. 10/561,724
Attorney Docket No. 10191/4458
Reply to Office Action of August 6, 2008

and 11, except that claim 15 depends from claim 12. New claims 14 and 15 respectively depend from claims 7 and 12 and are therefore allowable for the same reasons.

In summary, all of pending claims 7 and 9 to 15 are allowable.

Conclusion

In view of the foregoing, it is respectfully submitted that all pending claims 7 and 9 to 15 are in condition for allowance. It is therefore respectfully requested that the rejections (and any objections) be withdrawn. Since all issues raised by the Examiner have been addressed, an early and favorable action on the merits is respectfully requested.

Respectfully submitted,
KENYON & KENYON LLP

Dated: _____

11/7/2008

By: _____

Gerard A. Messina
Reg. No. 35,952
One Broadway
New York, NY 10004
(212) 425-7200

CUSTOMER NO. 26646

1610540